

R E M A R K S1. Claim Rejections – 35 U.S.C. §112, first paragraph

Claims **49 – 69** stand rejected 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office has identified several terms or clauses from these rejected claims that it is alleging are not supported by the specification as filed. Applicants respectfully traverse these assertions, one by one, below.

As a preliminary matter, Applicants note that it is not necessary for a specification to recite a claimed term exactly as it is recited in the claims. Rather, all that is necessary is that the specification adequately convey to one of ordinary skill in the art that the Applicant had possession of the claimed invention. See, for example, Koito Mfg. Co. v. Turn-Key Tech LLS, 381, F.3d 1142, 72 USPQ2d 1190, 1199 (Fed. Cir. 2004) which held that in evaluating whether the written description requirement has been fulfilled, the disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. Terms need not be used in *haec verba*, however. Instead, the court has explained that the written description requirement can be satisfied by words, structures, figures, diagrams, formulas, etc.” Thus, for example, Applicants respectfully submit that the claimed term “regulatory authority” as claimed would be adequately described by the specification’s use of the terms such as “regulatory group”, “regulatory body or group (e.g., a state, federal or local governmental regulating agency” and other terms (as cited below). Applicants provide below adequate written description support for each of the terms objected to be the Office. The citations provided below are exemplary only are not meant to imply that there is not other support for the subject claim terminology.

- (1) The term “regulatory authority” – page 7, line 11; page 55, line 29, page 84, line 2; page 85, line 3; pg. 107, line 1; pg. 127, line 1; pg. 130, line 9; pg. 132, line 22 and line 26; pg.137, line 10 refers to “regulatory group”; page 77, lines 6 – 8 refer to “a regulatory body or group (*e.g.*, a state, federal, or local government regulating agency; an industry regulatory or standardization

group)”; page 77, line 9 and line 13 each refers to “a state regulatory agency”; pg. 79, line 5 refers to a “regulator”; pg. 79, line 18 refers to a “regulatory body”; pg. 82, line 25 refers to “regulatory groups (*e.g.*, state government)”; pg. 99, line 29 refers to “a government regulatory group”; pg. 107, line 22 refers to a “regulatory groups (*e.g.*, state government)”; pg. 127, line 5 refers to “regulatory group (*e.g.*, a state tax agency)”; line 6 of the Abstract refers to “regulatory agencies”;

- (2) The term “expiration condition” – the passages on page 79, line 11 through page 81, line 28 describe various expiration conditions for authorization codes (*e.g.*, authorization code may expire at a certain date, in which case the expiration condition is the present date being the expiration date or later)
- (3) The claim limitation “only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature” (claim 49) – the passages on page 79, line 11 through page 81, line 28 describe the claimed embodiments
- (4) The term “only if the expiration condition has not yet been met, allowing play of the wagering game on the particular gaming device” (claim 59) – the passages on page 79, line 11 through page 81, line 28 describe the claimed embodiments
- (5) The term “that a wagering game has been mandated by a regulatory authority to only be played while a specified feature is enabled; receiving an authorization code from a gaming operator operating the game, the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled; and verifying, by a processor and by decrypting the authorization code, that the wagering game has only been allowed to be played while the feature was enabled” (claim 69) – the passage on page 77, lines 13 – 14 describe that a regulatory authority may mandate that a game be played while a specified feature is enabled; the passages on page 96, line 27 through page 97, line 29 describes that a casino operated device may communicate an authorization code and Fig. 17C illustrates that a casino server may communicate such data to an

authentication server of a regulatory group; the passages on page 97, line 30 through page 98, line 18 describe that a processor may decrypt an authentication code which may comprise usage date and the passages on page 100, line 29 through page 101, line 16 describe that the usage data may comprise an indication that a game or gaming device was played while a feature was activated

- (6) The term “the expiration condition is a maximum number of plays of the wagering game for which the authorization code is valid” (claims 51 and 61) – the passages on page 79, line 11 through page 81, line 28 support the claimed embodiments
- (7) The term “the expiration condition is a maximum sum of wagers for which the authorization code is valid” (claims 52 and 62) – page 80, lines 4 – 5 support this claimed embodiment
- (8) The term “prior to allowing play of the wagering game, confirming via the processor that an authorization code disallowing play of the wagering game has not been received from the regulatory authority” (claims 53 and 63) – page 78, line 7 through page 79, line 10 support the claimed embodiment
- (9) Apparently the entirety of claims 54 – 58 and 64 – 68 are deemed to be new matter: Applicants request that specific claim terms be identified as allegedly being new matter; since no prima facie case of new matter has been made with respect to these claims, Applicants are unable in good faith to reply to such general and unspecified allegations.

2. Claim Rejections – 35 U.S.C. §112, second paragraph

Claims **49** and **69** stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Office has rejected **49** because “the claim does not clearly state whether the allowing of a wagering game is accomplished via the processor or by a person” and claim **69** because “it is unclear who/what is ‘receiving an authorization code’, and in addition, whether the ‘gaming operator’ is a machine or person. Current Office Action, page 3 – 4, paragraph 5.

The Federal Circuit has explained that the second paragraph of § 112 contains two requirements: First, a claim must set forth what the applicant regards as his invention; and second, it must do so with sufficient particularity and distinctness, i.e., the claim must be sufficiently “definite.” Allen Eng’g Corp. v. Bartell Indus., 299 F.3d 1336, 1348 (Fed. Cir. 2002) (citing Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377 (Fed. Cir. 2000)). See also, MPEP § 2171.

“If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” Miles Laboratories, Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993); see also, S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1367 (Fed. Cir. 2001). The claims need set out and circumscribe a particular area with only a reasonable degree of precision and particularity. In re Moore, 58 C.C.P.A. 1042, 1046-1047 (C.C.P.A 1971). See also, MPEP § 2173.02 (“Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.”).

Breadth is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 693 (C.C.P.A 1971); see also, In re Robins, 429 F.2d 452, 458 (C.C.P.A 1970) (finding claims definite under § 112 (2) even though “[g]iving the language its broadest possible meaning...the breadth of the claims insofar as the catalyst is concerned is indeed immense. However, ‘Breadth is not indefiniteness.’” (citation omitted, emphasis added)). See also, MPEP § 2173.04.

The ability of an Examiner to enumerate examples encompassed by claim language points up the weakness of the Examiner’s indefiniteness argument that the meaning of the language cannot be ascertained with any degree of reliability. See, In re Robins, 429 F.2d at 458.

Thus, in determining whether a claim is sufficiently definite, the Examiner must analyze whether one skilled in the art would understand the bounds of the claim when read in light of the specification. See Allen Eng’g Corp. v. Bartell Indus., 299 F.3d 1336, 1348 (Fed. Cir. 2002) (citing Personalized Media Communs., L.L.C. v. ITC, 161 F.3d 696, 705 (Fed. Cir. 1998)).

There is no requirement under § 112, second paragraph, that a claim must be “a self-contained explanation of every step. That is not the role of claims. The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant.” S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1369 (Fed. Cir. 2001) (dismissing the district court’s objection “that the claims are not self-contained in that they do not explain that ‘video display information is produced by the controller’”).

The Examiner has not provided any proper legal basis for rejecting any of Claims **49 or 69** as indefinite under § 112 (2). The Examiner has failed to provide any evidence of record that would support the rejection of any of claims **49 or 69** as not being reasonably clear to one of ordinary skill in the art when considered, as is required for a proper analysis, in light of the disclosure. Contrary to law, the Examiner appears to equate breadth of a claim with indefiniteness. Simply because two or more examples are encompassed by a claim limitation does not render that claim indefinite. There is no attempt to establish an evidentiary basis for these conclusions. The Examiner also does not indicate that the disclosure was even considered. To the extent the Examiner believes the scope of any claim is broad, breadth is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 693 (C.C.P.A 1971). For any one of these reasons, the Examiner has failed to establish a prima facie case that any of claims **49 or 69** is indefinite. Applicants respectfully request that the rejection of claims **49 and 69** for indefiniteness must be withdrawn for lack of any supporting substantial evidence and for lack of any specific articulated reasoning.

3. Claim Rejections – 35 U.S.C. §101

Claims **49 – 58 and 69** stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter because “these are method and process claims that do not transform underlying subject matter....to a different state or thing, nor are they tied to another statutory class (such as a particular machine).” Current Office Action, page 4, paragraph 7. Applicants respectfully traverse. Each of these rejected claims explicitly recite that one or more steps are performed by a processor of a specified, particular device. Thus, each of these rejected claims qualify as patentable subject matter under the

current §101 standard and Applicants respectfully request reconsideration of this rejection.

4. Claim Rejections – 35 USC §102(e) over Giobbi

Claims **49 – 68** stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 6,749,510 to Giobbi (“Giobbi” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

A reading of the rejections of claims **49 – 68** reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Thus, the Examiner has not provided evidence that all of the claimed subject matter of any claim was known at the time of invention. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of any claim.

Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559 (Fed. Cir. 1992); Glaverbel S.A. v. Northlake Mkt’g & Supp., Inc., 45 F.3d 1550 (Fed. Cir. 1995).

The elements of the claim must either be inherent or disclosed expressly in the reference. Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560 (Fed. Cir. 1988).

There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Thus, the absence of any claim element from the reference negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565 (Fed. Cir. 1986).

Further, “[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See In re Spada, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990) (‘The [prior art] reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.’ (citations omitted)). Although this disclosure requirement

presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. An expert's conclusory testimony, unsupported by the documentary evidence, cannot supplant the requirement of anticipatory disclosure in the prior art reference itself. See Jamesbury Corp. v. Litton Indus. Prods., Inc., 756 F.2d 1556, 1563, 225 U.S.P.Q. (BNA) 253, 257-58 (Fed. Cir. 1985)". Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461 (Fed. Cir. 1997).

Also, the elements in the prior art must be arranged as they are in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226 (Fed. Cir. 1988).

Applicants respectfully submit that Giobbi fails to teach or suggest the following limitations of the claims as follows:

With respect to independent claim **49** (and claims **50 – 58**, dependent therefrom and thus including the same limitations):

- (i) *prior to allowing play of a wagering game including a particular feature and via a processor of a device operable to facilitate the wagering game, determining whether an authorization code for enabling play of the wagering game with the particular feature has been received from a regulatory authority;*
- (ii) *verifying, via the processor, an expiration condition for the authorization code; and*
- (iii) *only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature*

The Office has asserted that these claim limitation (i) is taught by Giobbi at col. 3 – 4. Applicants respectfully disagree. At col. 3 – 4 Giobbi describes that a plurality of games may be made available for play at player terminals by being stored at a central casino server. Upon a player request, one of these games may be downloaded and made available at any of the game terminals. There is absolutely no description or enablement for an authorization code as a distinct concept in Giobbi. In fact, Giobbi is explicit in

stating that any of the games are downloaded and made available for play upon a mere player request, with no authorization code or any form of authorization from any entity being required prior to such a download. Further, Giobbi is limited to describing the downloading of a game per se, not a game with a particular feature. The Office is reading the meaning out of the claim with its unreasonably loose interpretations...the claim recites allowing play of a particular game with a particular feature based on a determination of whether an authorization code for play of the game with the particular feature has been received. Thus, (a) the terms “wagering game” and “feature” are distinct terms used within the claim and represent two distinct concepts that both need to be found in the reference in order for it to anticipate; and (b) the concept of an authorization code being received needs to be found in the reference. With respect to issue (a), the Office is conflating two terms into a single concept, which is legally inappropriate. With respect to concept (b), the Office is providing no support for how the reference teaches an authorization code.

With respect to claim limitation (ii), the Office has asserted that this claim limitation is anticipated by Giobbi at col. 10, lines 13 – 49. Applicants respectfully disagree. This passage of Giobbi provides no description or enablement for an authorization code, much less for an expiration condition for an authorization code, much less for an expiration condition for an authorization code of a wagering game with a particular feature.

With respect to claim limitation (iii), the Office has asserted that this claim limitation is anticipated by Giobbi at col. 5, lines 13 – 25. Applicants respectfully disagree. Again, there is no support in Giobbi for authorizing a game with a particular feature. Giobbi does not speak to particular features of game and authorizing such with authorization codes or otherwise. Further, the Office’s own interpretation of Giobbi with respect to claim limitations (ii) and (iii) is inconsistent and does not support a case of anticipation. With respect to limitation (ii), the Office is interpreting the expiration condition to be a time at which a game is made available for downloading to a terminal. With respect to claim limitation (iii), however, the Office is interpreting the expiration condition to be a time during which a gaming device is idle. These are two distinct

concepts in Giobbi, neither of which meets the claim limitations and which cannot be interpreted as anticipating a singular claim term.

Finally, with respect to each of the claim limitations (i) through (iii), Applicants respectfully submit that it is unreasonable for the Office to interpret “regulatory authority” as the central server system of a casino (Current Office Action, page 6, line 3). The specification clearly distinguishes between a casino and a regulatory authority as two distinct entities, as evidenced by numerous passages of the written description, the figures and the claims (where a casino operator and a regulatory authority are used as two distinct terms that are not used interchangeably). Applicants respectfully submit that claim terms must be interpreted in light of the specification in which case a regulatory authority for purposes of claims **49 – 68** is distinct from a casino operator or a server of a casino operator.

With respect to claim **59** (and dependent claims **60 – 68**, which include each of these limitations by virtue of their dependency):

prior to allowing play of a wagering game on a particular gaming device, determining via a processor of a device operable to facilitate the wagering game whether an authorization code for enabling play of the wagering game on the particular gaming device has been received from a regulatory authority;

verifying, via the processor, an expiration condition for the authorization code; and

only if the expiration condition has not yet been met, allowing play of the wagering game on the particular gaming device

Applicants arguments with respect to (i) Giobbi lacking a description of any authorization code, much less an authorization code being a prerequisite for making available a game with a particular feature and (ii) a regulatory authority being distinct

from a server of a casino operator (both provided with respect to claim **49**) are equally applicable with respect to the limitations of claims **59 and 60**.

For all of the above reasons, Applicants respectfully request reconsideration of the §102(e) rejection of claims **49 – 68** over Giobbi.

5. Claim Rejections – 35 U.S.C. §102(e) Rejection over Nguyen

Claims **49 – 51, 53 – 61 and 63 – 69** stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2002/0071557 (“Nguyen” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

With respect to claims **49 – 51, 53 – 61 and 63 – 68**, Applicants respectfully submit that Nguyen does not teach or suggest an authorization code from a *regulatory authority*, much less an authorization code that enables play of a wagering game with a *particular feature*. Nguyen is directed towards secure communications over a casino network between a casino server and a gaming device. Nguyen is completely lacking in teaching receiving an authorization code for a game having a particular feature, much less receiving such a code from a *regulatory authority*. Similar to the teachings of Giobbi, Nguyen addresses information between a casino server and a gaming machine on the casino network. It does not describe or enable receiving information from a regulatory authority, which (as argued above with respect to the rejections over Giobbi) is an entity that is distinct from a casino operator, as a complete reading of the specification as filed makes clear. Interpreting the regulatory authority to be equivalent to a casino operator is counter to the explicit description of the specification as filed. Further, Nguyen (as Giobbi) is limited to licenses for games per say and does not describe or enable licensing a game *with a particular feature*. Nguyen is completely silent on the concept of a game being authorized with a particular feature versus a game being authorized without the particular feature, which is what the claimed embodiments are concerned with. The Office is inappropriately reading out entire claim limitations by interpreting the claim term “wagering game with a particular feature” as “wagering game.”

With respect to claim **69**, Applicants respectfully traverse this rejection on the grounds that Nguyen fails to teach or suggest *verifying, by a processor and by decrypting the authorization code, that the wagering game has only been allowed to be played while the feature was enabled*. None of the passages of Nguyen offered by the Office in support of the rejection of claim **69** (Current Office Action, page 10) address this claim limitation. While Nguyen describes game licenses, Nguyen is completely silent on authorizing (by any entity) play of a wagering game with a particular feature much less verifying that the game has only been allowed to be played while the feature was enabled. Nguyen provides no enablement for tracking such particular usage much less verifying it in any manner; as such Nguyen does not anticipate claim **69**.

Applicants silence with respect to the Office's other various assertions not explicitly addressed in this paper, including assertions of (1) what the cited reference(s) teach or suggest, (2) the Office's interpretation of claimed subject matter or the Specification and (3) assertions of what knowledge was generally known in the art at the time of invention, is not to be understood as agreement with the Office. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham via the contact information provided below.

Authorization to Charge Fees

Applicants believe that a one month extension of time is required to make this Amendment and Response timely. Accordingly, please grant a petition for a one month extension of time necessary to make this submission timely. Additionally, please charge any fees required for this submission, including a one month extension of time fee as follows:

Deposit Account: 50-0271

Order No. 02-034

Charge any additional fees or credit any overpayment to the same account.

Respectfully submitted,

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Date

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